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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,358	01/27/2001	Randall F. Hornick	17243-00035	6083

7590

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EXAMINER

HECK, MICHAEL C

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,358

Applicant(s)

HORNICK ET AL.

Examiner

Michael C. Heck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/30/01, 4/26/02</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS cont'd 10/7/02</u> . |

DETAILED ACTION

1. The following is a First Office Action in response to the application filed 27 January 2001. Claims 1-74 are pending in this application and have been examined on the merits as discussed below.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "1040" has been used to designate the display screen of Figure 48 and Figure 49. Figure 49 displays different information than Figure 48.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 152.

4. The "Transmittal of Formal Drawings" received 18 December 2002 was missing Figure 44.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required

corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:
- On page 14, Para 94, Applicant is referring to the business profile form 200 and indicates a "Customer Shared Space check box" however a "Customer Shared Space check box" does not exist on the form.

The above citation is a mere guide. Applicant is requested to review the specification thoroughly to eliminate additional errors. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1-15** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to

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promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For the process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, **claim 1** only recites an abstract idea. As to **claim 1**, the recited steps of prompting a user to create a business profile; prompting a user to create a deal, including identifying deal team members; and notifying members of the deal team of tasks to be performed and milestones does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The method only constitutes an idea for managing a deal process, therefore, is deemed to be directed to non-statutory subject matter.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implications of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above. Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed

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invention produces a process (i.e., repeatable) to manage deals (i.e., useful and tangible).

Looking at the claims as a whole, nothing in the body of the claims recite any structure or functionality to suggest that a computer performs a task.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, the same rejection as stated above for claim 1 applies to **claims 2-15**.

8. **Claims 43-47** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claim 43 claims a database and claims 44-47 describes the information in the database, therefore the claims are considered to be directed to non-functional descriptive material. The claims as a whole are considered to be a mere arrangement or compilation of facts or data that are merely stored so as to be read or outputted by a computer without creating any functional interrelationship either as part of the stored data or as part of the computing processes performed by the computer. A database, therefore is not a process, machine, manufacture or composition of matter. Please see MPEP § 2106.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-74** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredell et al. (U.S. Patent 6,678,698) in view of Veldhuisen (U.S. Patent 6,480,850). Fredell et al. disclose methods and systems for identifying prospective customers and managing deals comprising:

- **[Claim 1]** prompting a user to create a deal, including identifying deal team members (col. 2, lines 54-57, col. 4, lines 33-59, and col. 5, lines 63-67, Fredell et al. teach providing a method and system for securely communicating and managing project information among multiple project participants. Projects involving financial or M & A transactions are particularly suitable and includes divestiture deals. Communications between entity and target may include various personnel such as their respective legal counsel team, financial advisors, or other advisors including external advisors relative to the acquisition entity and target.); and
- notifying members of the deal team of tasks to be performed and milestones (col. 3, lines 11-28, Fredell et al. teach a method of communicating and managing project information. The method allows for storing project-related information including project documentation in a database. The method further provides an interface screen. The interface screen is configurable to identify a plurality of project tasks. The interface screen includes a data field for defining a respective time window over which each of said task is to be performed by at least one project participant. The method allows for posting over the global communications network to selected project participants the plurality of project tasks. The Examiner interprets "time window over which each of said task is to be performed" to be a milestone.).

Fredell et al. fail to teach the steps of prompting a user to create a business profile.

Fredell et al. does teach that once the financial or other underwriting institution has established an account with the service provider, documents in electronic form can be uploaded to the secure site maintained by the service provider (col. 5, lines 22-34).

Veldhuisen teaches a method and apparatus for managing consumer notification and access and a means of correction and change of preferences for privacy or data

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protection in a data warehousing system including a physically separate by dependently connected data mart. Project management is critical to the success of Dependent Data Mart Migration to meet obligations to the customer and for elimination of "scope creep", a project plan is required for all implementations. A project plan governs the Business Profile and Consumer Profile (col. 2, line 64 to col. 3, line 2, and col. 9, lines 46-59). It would have been obvious to one of ordinary skill in the art to include the business profile of Veldhuisen with the teachings of Fredell et al. since Fredell et al. teach providing a method and system for securely communication and managing project information among multiple project participants (col. 2, lines 54-57). Shared data is the foundation for decision making in a collaborative environment. Veldhuisen teaches retailer applications and third party applications have access only to such data as permitted by the database view provided (col. 4, lines 55-57). Fredell et al. teach providing read-only capability to selected project participants (col. 3, lines 3-7). Shared data is allowed to be used in the decision making process, therefore, becoming the foundation for the decision making process in the collaborative environment.

- **[Claim 2]** the step of prompting a user to establish user accounts with authority levels of at least one of user, manager, and administrator (Fredell et al., col. 6, lines 21-26, Fredell et al. teach the person posting the document generally decides who gets access to that document and may add or change indexing information for the document. After the person posting the document has indicated who should receive access, the document will be instantly available to authorized project participant.).
- **[Claim 3]** the step of prompting an administrator to set up a structure of divisions and sub-divisions for the business (Fredell et al., col. 4, lines 13-31, Fredell et al. teach project managers may perform all of the interactions performed by other project participants, but they may also work in

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conjunction with the Network Service Provider administrator on project startup to allocate initial tasks and leverage historical information that the Network Service Provider may have archived from previously performed similar projects. The Network Service Provider administrator is responsible for setting up the system for a client and ensuring that the system is robust and fully functional.).

- **[Claim 4]** the step of prompting a user through one of a personal portal or a personalized web page (Fredell et al., col. 5, lines 13-21, Fredell et al. teach users can access the service via a communications link provided by a private network provider or a public Internet access provider such as AOL or Timer Warner Cable.).
- **[Claim 5]** at least one of an originator page, a prospect page, an intermediary page and a customer page (Fredell et al., col. 5, lines 22-34, Fredell et al. teach the system provides a fully provisioned, turnkey service for users, e.g., financial firms, accounting firms, investment firms or other underwriting institutions. Once the financial or other underwriting institution has established an account with the service provider, documents in electronic form can be uploaded to the secure site maintained by the service provider. The Examiner interprets this process to be the establishment of the originator page.).
- **[Claim 6]** the step of prompting a user to create at least one of a work group, a my profile and a user profile (Fredell et al., col. 5, lines 48-52, Fredell et al. teach the network service provider provides a secure virtual network (or "intranet") for the entities that support the secure electronic dissemination of confidential information documents, memoranda and related information and associated communications. The Examiner interprets the process to be establishing a work group.).
- **[Claim 7]** the step of prompting a user to create at least one of a deal summary, a deal timeline, a deal menu, a deal workspace, a deal discussions area, a deal library and a deal profile (Fredell et al., col. 3, lines 11-28, Fredell et al. teach an interface screen is configurable to identify a plurality of project tasks. The interface screen includes a datafield for defining a respective time window over which each of said tasks is to be performed by at least one project participant. The Examiner interprets the time window to be a deal timeline.).
- **[Claim 8]** the step of creating a briefing page, including channels for both company users and non-company users (Fredell et al., col. 4, lines 32-41, and col. 5, lines 48-52, Fredell et al. teach the process can be used for many types of communications between different parties that are associated

for a temporary transaction or project, but as competitors or for other reasons, are not suitable for a permanent communications network (LAN or WAN) as might be used for a single government agency or single corporation. The network service provider provides a secure virtual network (or "intranet") for the entities that support the secure electronic dissemination of confidential information documents, memoranda and related information and associated communications.).

- **[Claim 9]** the step of building a library for the deal (Fredell et al., col. 3, lines 11-28, Fredell et al. teach storing project-related information including project documentation in a database.).
- **[Claim 10]** the step of providing a deal status to deal team members (Fredell et al., col. 2, lines 54-57, and col. 15, lines 18-20, Fredell et al. teach a method and system for securely communicating and managing project information among multiple project participants. The system provides a project status that gives a user a snapshot of the project as it applies to them and their role in the process.).
- **[Claim 11]** the step of prompting a user for feedback (Fredell et al., col. 15, lines 29-36, Fredell et al. teach a shared discussion forum where project participants can raise and respond to project issues.).
- **[Claim 12]** the step of providing capability for at least one of a search of profiles of deal team members, a search across all businesses and a deal search, search results in a format specified by the user (Fredell et al., col. 3, lines 29-48, and col. 15, lines 37-41, Fredell et al. teach an on-line directory of project participants including standard demographics, their position on the team as a project manager or basic contributor, and their access to different systems areas, such as scanned documents, but not task administration. The interface screen is configurable to identify a plurality of project tasks.).
- **[Claim 13]** the step of prompting a user to create or modify at least one of task templates for the deal and library templates for the deal (Fredell et al., col. 15, lines 44-48, Fredell et al. teach the ability for a project manager to create, assign, and reassign tasks to project participants, and a repository of standard task templates grouped by industry and by function.).
- **[Claim 14]** the step of prompting a user to create a customer company profile (Fredell et al., col. 3, lines 11-28, col. 4, lines 32-41, and col. 5, lines 48-52, Fredell et al. teach the method allows for storing project-related information including documentation in a database. The process can be used for many types of communications between different parties that are associated for a temporary transaction or project, but as competitors or for

other reasons, are not suitable for a permanent communications network (LAN or WAN) as might be used for a single government agency or single corporation. The network service provider provides a secure virtual network (or "intranet") for the entities that support the secure electronic dissemination of confidential information documents, memoranda and related information and associated communications. Veldhuisen, col. 2, line 64 to col. 3, line 2, and col. 9, lines 46-59, Veldhuisen teaches a method and apparatus for managing consumer notification and access and a means of correction and change of preferences for privacy or data protection in a data warehousing system including a physically separate by dependently connected data mart. Project management is critical to the success of Dependent Data Mart Migration to meet obligations to the customer and for elimination of "scope creep", a project plan is required for all implementations. A project plan governs the Business Profile and Consumer Profile.).

- **[Claim 15]** the step of prompting a user to create or modify an index card functionality used to track information on files uploaded and downloaded from the library (Veldhuisen, col. 3, lines 3-9, Veldhuisen teaches a database management system for storing data from a plurality of consumer database tables, with irrevocable logging of all access, whether granted or denied, to the data contents stored in the consumer data tables, and a privacy metadata system that administers and records all data, users and usage of data that is registered as containing privacy elements.).
- **[Claim 24]** said server is configured to assign tasks for members of the deal team (Fredell et al., col. 15, lines 44-45, and col. 16, lines 28-30, Fredell et al. teach the ability for a project manager to create, assign, and reassign tasks to project participants. When implemented on a computer, the computer program code segments configure the computer to create specific logic circuits or processing modules.).
- **[Claim 29]** said server is configured for at least one of prompting a user to create and modify task templates including milestones and tasks for the deal and prompting a user to create and modify library templates for the deal (Fredell et al., col. 15, lines 46-53, and col. 16, lines 28-30, Fredell et al. teach a repository of standard task templates grouped by industry and by function. The project manager can select from a standardized list of questions to create and assign tasks to individuals on the project team. The user can see a list of their tasks with the task description, status, and due date. When implemented on a computer, the computer program code segments configure the computer to create specific logic circuits or processing modules.).

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Claims 16-23, 25-28, and 30-74 substantially recites the same limitations as that of claims 1-15, 24, and 29 with the distinction of the recited method being a system, apparatus, database, method, computer readable medium, and computer. Fredell et al. teach computer-implemented processes and apparatus, computer-program code including computer-readable instructions embodied in tangible media, such as floppy diskettes, CD-ROMs, hard drives, or any other computer-readable storage medium, wherein, when the computer program code is loaded into and executed by a computer, the computer becomes an apparatus for practicing the process (col. 16, lines 19-30). Hence the same rejection for claims 1-15, 24, and 29 as applied above applies to claims 16-23, 25-28, and 30-74.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Salas et al. (U.S. Patent 6,230,185) disclose a method and apparatus for facilitating communication between collaborators in a networked environment.
- Mori et al. (U.S. Patent 6,073,829) discloses an electronic transaction method and system.
- Cohen et al. (U.S. Patent 6,507,845) disclose a method and software for supporting improved awareness of and collaboration among users involved in a task.

- Smiga et al. (U.S. Patent 6,421,678) disclose a method and apparatus for group action processing between users of a collaboration system.
- PR Newswire (PR Newswire, eProject.com Ships Enhanced Enterprise Project Management and Collaboration Solution, PR Newswire, 21 September 2000 [PROQUEST]) discloses eProject.com has designed its latest release to provide a rich environment for project planning, team collaboration, and cross-project reporting with features to include document management, knowledge management to include best-practice templates with pre-defined task schedules and project documents, project management and scheduling, team collaboration, and enterprise reporting.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Heck whose telephone number is (703) 305-8215. The examiner can normally be reached Monday thru Friday between the hours of 8:00am - 4:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (703) 305-9643. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

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(703) 746-9419 [Informal/Draft communication, labeled "**PROPOSED**" or "**DRAFT**"]

Hand delivered responses should be brought to 220 South 20th Street, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

mch
04 January 2005


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